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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,436	09/15/2005	Helmuth Eggers	510.1150	5593

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EXAMINER	
HANNAHER, CONSTANTINE	
ART UNIT	PAPER NUMBER
2884	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/549,436	EGGERS ET AL.	
	Examiner	Art Unit	
	Constantine Hannaher	2884	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20050915*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

National Stage Application

1. The Examiner acknowledges consideration of the International Preliminary Report on Patentability in International Application PCT/EP04/02165. MPEP § 1893.03(e).

Information Disclosure Statement

2. As set forth in MPEP § 609:

> 37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

Note the failure to identify the "patent application publication number" as it appears on the face of the document.

3. The information disclosure statement filed September 15, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Note the omission of the actual Japanese patent documents.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nakamura (US007050089B2).

With respect to independent claim 8, Nakamura discloses a night vision system (Fig. **1**) which is automotive (column 1, lines 6-9) and which comprises an active infrared illumination **20**, a camera **10a** for recording infrared images (column 3, lines 8-23), an image display **4** for reproducing image information, an evaluator (column 6, lines 43-62) arranged and configured to analyze parameters to activate the active infrared illumination **20** as a function of the analysis, and a controller (column 7, lines 21-32) independent of the evaluator for activating and deactivating the night vision system. In view of the response to the manipulation of the operation key by the driver as described by Nakamura, the image display **4** is activated and deactivated directly by the controller independently of the parameter analysis.

With respect to dependent claim 9, the controller in the system of Nakamura comprises a switch (operation key) used for activating and deactivating the image display **4** (column 7, lines 21-32).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (US007050089B2).

With respect to dependent claim 10, the automobile in Nakamura includes an ignition assembly (key and lock) which is diagnostic of, *e.g.*, power transmission from the battery to various systems. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made that the operability of the controller (whether or not the operation key works) was a function of that diagnostic system. Furthermore, the automobile in Nakamura is subject to a diagnostic system when serviced (*e.g.*, using OBD-II). It does not require more than ordinary skill in the art to decide that a mechanic should be able to operate the controller as a function of the diagnostic system attached to the vehicle in order to test, evaluate, diagnose, and the like as for any other system on the automobile. Accordingly, operability of the controller in Nakamura as a function of diagnostic systems in the plural would have been obvious to one of ordinary skill in the art at the time the invention was made.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (US007050089B2) as applied to claim 10 above, and further in view of Matko *et al.* (US20040119866A1).

With respect to dependent claim 13, apparatus claims cover what a device is, not what a device does. An invention need not operate differently than the prior art to be patentable, but need only *be* different.[1] See *e.g.*, *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1390-91, 7 USPQ2d 1222, 1224-25 (Fed. Cir.), cert. denied, X U.S. X, 109 S.Ct. 395 (1988); *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1098, 227 USPQ 337, 348 (Fed. Cir. 1985), vacated, 475 U.S. 809 [229 USPQ 478] (1986), on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). [Citations omitted] *Hewlett-Packard Co. v. Bausch & Lomb, Inc.,* 15 USPQ2d 1525 (Fed. Cir. 1990). Accordingly, the scope of claim 13 is not different from the scope of claim 10, see the rejection of claim 10. Nevertheless, Matko *et al.* teaches an automotive night vision system (Fig. **2**) in which the image display **20** is operated to display the image from infrared camera **30** upon performance of the calibration process or thermal equalization process **140** (Fig. **1**), that is, when a satisfactory quality is ascertained (paragraph [0013]). In view of the advantage of an image appearing only after the process **140** is completed (paragraph [0014]) as taught by Matko *et al.*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nakamura such that it behaved as suggested.

10. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (US007050089B2) in view of Strumolo *et al.* (US006535242B1).

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[1]Or perhaps more accurately, be *unobviously* different.

With respect to dependent claim 11, the camera **10a** in the system of Nakamura operates in the visible wavelength range (Fig. **6**). Strumolo *et al.* teaches that in automotive night vision systems comprising cameras for recording infrared images (column 3, lines 57-61) operating in the visible wavelength range (column 6, lines 15-23), it is known to provide more than one such camera and reproduce the image information from the plurality of cameras on the display **12** (Fig. in view of cameras **18, 20, 22, 24**). In view of the advantageous stereoscopic information taught by Strumolo *et al.*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nakamura to further comprise at least one additional camera sensitive in the visible wavelength range coupled to the night vision system such that the image display **4** reproduced image information from the additional camera(s).

With respect to dependent claim 12, both Nakamura and Strumolo *et al.* teach that when the infrared illumination is inactive, image information recorded by the camera operating in the visible wavelength range is shown on the image display.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (US007050089B2) in view of Ishikawa *et al.* (EP1032209A2).

With respect to dependent claim 14, apparatus claims cover what a device is, not what a device does. An invention need not operate differently than the prior art to be patentable, but need only *be* different. See the rejection of claim 13. Accordingly, the scope of claim 14 is not different from the scope of claim 8, see the rejection of claim 8. Nevertheless, Ishikawa *et al.* teaches an automotive vision system (Fig. **1**) in which the image display **21** is operated to display the image from camera **13** but upon a judgment of an improper picture (a malfunction) by element **23** the image display **21** is operated to provide a message (paragraph [0045]). The provision of a message is not quite a deactivation of the image display, since a similar message is provided upon recovery

(paragraph [0046]), but it would have been obvious to one of ordinary skill in the art at the time the invention was made to emphasize the reduction in monitoring accuracy by a message that was larger, more colorful, and the like than the message reporting the restoration such that the reduction message obscured the image to the extent that the display of the image would be considered deactivated. In view of the improved reliance which a driver may place on the display when the image is active as suggested by Ishikawa *et al.*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nakamura to obscure the image display as by deactivating it when a malfunction prevents image information from proceeding normally.

Response to Submission(s)

12. The amendment filed September 15, 2005 has been entered.

13. This application has been published as US2006/0203091A1 on September 14, 2006.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Constantine Hannaher/

Constantine Hannaher
Primary Examiner
Art Unit 2884

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